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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/056,343	04/07/98	LOEBVORG	U 3556.224-US

HM22/0121

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EXAMINER

MOORE, W

ART UNIT

PAPER NUMBER

1652

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DATE MAILED: 01/21/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/056,343**

Applicant(s)  
**Loevborg**

Examiner  
**William W. Moore**

Group Art Unit  
**1652**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 24-39 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 24-39 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/050,172.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Applicant's submissions of Information Disclosure Statements, Paper Nos. 3-5 filed July 9, July 30, and November 20, 1998, are hereby acknowledged and executed copies of the Forms 1449 listing the references cited will accompany a first action on the merits in this application. Applicant's preliminary amendment A, filed with the application on 5 April 7, 1998, has been entered. Claims 1-23 were canceled and new claim 24-39 were added at Applicant's request. Receipt is acknowledged of papers submitted under 35 U.S.C. §119, specifically EPO Patent Application 90-610092.2 filed December 5, 1990, which papers have been placed of record in the file of the parent U. S. application serial No. 08/050,172. A Notice of Draftsman's Patent Drawing Review, stating 10 informalities requiring correction, accompanies this communication. In preparing the following restriction requirement it was noted that new claims 35 and 37 are identical.

This application contains claims directed to the following patentably distinct species of the claimed invention:

15 Species A, methods for producing variant proteins of the class of industrial and process enzymes described in claims 25-29 and the variant products of claims 33-34; and

Species B, methods for producing variant proteins of the class of medical proteins described in claims 30 and 31 and the variant products of claims 35-37.

20 Applicant is required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 24 and 32 are generic. The generic claims 24 and 32 will be examined herein to the extent that they read on the elected species.

25 Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless 30 accompanied by an election.


Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either 35 instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

40 A telephone call was made to Ms. Carol E. Rozek on January 12, 1999, to request an oral election to the above restriction requirement as to species, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is (703) 308-0583. The examiner can be reached Monday through Friday from 9:00 AM to 5:30PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax, can be reached at (703) 308-4216. Papers related to this application may be submitted to Group 1800 by facsimile transmission. The faxing of such papers must conform with the notice published November 15, 1989 in the Official Gazette, 1096 OG 30. Informal and unofficial communications may be sent to the Art Unit 1652 FAX number, (703) 308-0294. Official filings should be sent to the Technical Center 1600 FAX number which is (703)308-4556.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. §122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

William W. Moore  
January 12, 1999

  
Robert A. Wax  
Supervisory Patent Examiner  
Technology Center 1600